



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Marc Tillis

Appln. No.: 10/800,578

Filed : March 15, 2004

Title : Method of Preparing Egg Nuggets

Docket No.: LL11.12-0089

Group Art Unit: 1761

Examiner: Anthony J. Weier

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SENT VIA EXPRESS MAIL
Express Mail No.: EQ 141629632 US

Sir:

This Response is submitted in reply to the Office Action mailed on February 13, 2007. In the Office Action, the Examiner did not object to any claims and did not reject any claims, but instead stated a species election requirement under 35 U.S.C. §121. With this Response, no claims are amended, no claims are canceled, and no new claims are added. Upon entry of this Response, the above-identified application will include claims 1-59.

In the Office Action, the Examiner alleged the present application contains claims directed to two patentably distinct species and further alleged "Restriction to one of the following inventions is required under 35 U.S.C. §121." The Examiner alleged:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-10, 13-22, and 24-42 are generic.

The Examiner characterized the application as containing claims directed to the following patentably distinct species:

A. The method of making an egg-containing product being free of water or having only incidental water (claims 11 and 12).

B. The method of making an egg-containing product comprising the addition of water (claims 23 and 43-59).

The Examiner also alleged:

The species are independent or distinct because the products with water added have different characteristics than those with essentially no water (see instant specification, page 9, first paragraph).

and concluded by stating:

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

As the Examiner requested, Applicant hereby elects, with traverse, the species of the present invention that comprises added water, which the Examiner alleges is exemplified by claims 23 and 43-59.

Applicant traverses the Examiner's statement that the first paragraph on page 9 of the present application supports the Examiner's contention about the two species identified by the Examiner allegedly being independent or distinct "because the products with water added have different characteristics than those with essentially no water." The first paragraph on page 9 of the present application is recited below:

The egg-based substance may optionally include added water, though numerous embodiments are free, or essentially free, of any added water. If added water is included, the concentration of the added water in the egg-based substance may be up to 50 weight percent, based on the total weight of the egg-based substance. As used herein with regard to the egg-based substance, the term "added water" means water added separately from any other component(s) of the egg-based substance and water included as part of any reconstituted (i.e. made from a dry or dried form) component(s) of the egg-based substance.

Clearly, this paragraph does not support the Examiner's contention about the two species identified by the Examiner being independent or distinct "because the products with water added have different characteristics than those with essentially no water." This paragraph does not say anything about the products with added water having different characteristics than those with essentially no added water. Appropriate correction of the basis for support of the Examiner's contention why the two species identified by the Examiner are allegedly independent or distinct is respectfully requested.

Applicant also traverses the Examiner's characterization of claim 23 as allegedly belonging to the species of the present invention that comprises added water and the Examiner's characterization of the present invention as including a species "being free of water or having only incidental water." Claim 23 reads as follows:

23. The method of claim 22 and wherein:
the natural liquid egg component comprises free water; and
the cooked water-absorbent material comprises bread crumbs that absorb
free water of the natural liquid egg component.

and depends from independent claim 22 that reads as follows:

22. A method, the method comprising blending an egg-based substance and a cooked water-absorbent material together to form an egg-based material, the egg-based substance comprising a natural liquid egg component.

The Examiner's species election requirement is premised on (or more accurately should have been premised on) species comprising added water and species being free or essentially free of added water. The Examiner's characterization of the present invention as including a species "being free of water or having only incidental water" is erroneous.

Instead, the present invention includes embodiments that "optionally include added water" and embodiments that are "free, or essentially free, of any added water," as explained in the first paragraph on page 9 of the present application, which also defines the meaning of the "added water" terminology:

The egg-based substance may optionally include added water, though numerous embodiments are free, or essentially free, of any added water. If added water is included, the concentration of the added water in the egg-based substance may be up to 50 weight percent, based on the total weight of the egg-based substance. **As used herein with regard to the egg-based substance, the term "added water" means water added separately from any other component(s) of the egg-based substance and water included as part of any reconstituted (i.e. made from a dry or dried form) component(s) of the egg-based substance.**

Emphasis added. Thus, in satisfaction of this traversal, Applicant respectfully requests that the Examiner properly define the species in terms of those comprising "added water" and species being free or essentially free of "added water."

Furthermore, in satisfaction of this traversal, Applicant respectfully requests that the Examiner correct the Examiner's erroneous characterization of claim 23 as belonging to the species that comprises added water. Claim 23 does not specify the existence of any "added water," but instead specifies "the natural liquid egg component comprises free water." The distinction between "free water" and "added water" is explained in the above-identified application, such as at lines 10-11 on page 13:

The natural liquid egg component(s) of the egg-based substance contain free water; added water may also be included in the egg-based substance.

Clearly, claim 23 does not belong to the species that explicitly comprises "added water." Appropriate correction by the Examiner is respectfully requested.

As noted above, Applicant has elected the species comprising "added water," and the Examiner alleged claims 23 and 43-59 read on this species that comprises "added water." This contention of the Examiner is erroneous, with regard to claim 23. Instead, only claims 43-59, and not claim 23, read on (explicitly encompass) the elected species that comprises "added water."

Also, the Examiner contends that claims 1-10, 13-22, and 24-42 are generic. However, in recognition of the Examiner's erroneous contention that claim 23 reads on the species that comprises "added water," it is evident the list of claims generic to the two species identified by the Examiner should instead include claims 1-10 and 13-42, since claim 23 recites nothing about the presence or absence of "added water." Appropriate correction by the Examiner is respectfully requested.

CONCLUSION

Claims 1-59 are each believed allowable. Therefore, consideration and allowance of claims 1-59 is respectfully requested. The Examiner is invited to contact Applicant's below-named attorney, Philip F. Fox, to facilitate allowance of the above-identified application.

Respectfully submitted,

Date: February 13, 2007

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